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PRE-APPEAL BRIEF REQUEST FOR REVIEWDocket Number (Optional)
29250-000524/US

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

On _____

Signature _____

Typed or printed name _____

Application Number
09/503,096Filed
February 11, 2000First Named Inventor
Katherine G. AUGUSTArt Unit
2135Examiner
T. B. Truong

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages are provided.

I am the

☐ applicant/inventor

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 35,416.

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____


Signature 45,274

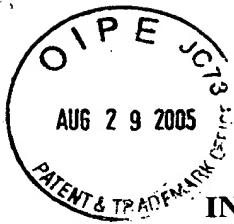
Gary D. Yacura
Typed or printed name

703-688-8000
Telephone number

August 29, 2005
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Katherine G. AUGUST et al.
Application No.: 09/503,096
Filed: February 11, 2000
Group: 2135
Examiner: T. B. Truong
For: METHOD AND SYSTEM FOR CAPTURE OF LOCATION
SPECIFIC MEDIA RELATED INFORMATION AND DELIVERY
THROUGH COMMUNICATIONS NETWORK
Attorney Docket No.: 29250-000524/US

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Randolph Building
401 Dulany Street
Alexandria, VA 22314
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August 29, 2005

REASONS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

Dear Sir:

Further to the concurrent filing of the attached Notice of Appeal, the following remarks are submitted in connection with the above-identified patent application under the Pre-Appeal Brief Review.

Claims 1-26 are pending in the current application. Claims 1, 4, 14 and 15 are independent claims.

Material under Review

Review is requested for the rejection of claims 1-26 under 35 U.S.C. § 103(a) with respect to the Chen patent in view of the Moskowitz patent.¹

Each of independent claims 1, 4, 14 and 15 recite one of a transmitting and delivering step which is triggered **in response** to information extracted or decoded from a watermark in a signal. The Examiner alleges that Chen discloses the claimed responsive transmitting step

¹ See page 2 of the Office Action mailed June 6, 2005.

in the Chen Patent with reference to column 1, lines 34-38.² However, Appellant respectfully submits that the Examiner is mischaracterizing the cited portion of the Chen patent.

A review of the cited portion³ indicates that Chen simply discloses embedding/decoding of a watermark signal, and not transmissions or other operations in response to the decoded watermark. Appellant cannot understand how Chen can disclose operations performed in response to a decoding operation if the alleged operations occur either before the decoding or in fact are the actual decoding.⁴

The Examiner combines the Moskowitz reference with Chen for deficiencies of Chen unrelated to the above-described deficiency.⁵ While Appellant agrees with the Examiner in that Chen includes deficiencies in addition to the above-described deficiency, Appellant respectfully submits that Moskowitz is insufficient in disclosing or suggesting at least the above-described deficiency of Chen.⁶

The Examiner has maintained the above-described arguments despite Appellant's previous arguments and issued a final Office Action on June 6th, 2005.⁷ In the "Response to Argument" section of said final Office Action, the Examiner proposed new arguments in support of the position that Chen discloses the above-described deficiency.⁸ Appellant will now explain how the Examiner's new position contains the same deficiencies as above-described with respect to the Examiner's old position.

Initially, since the Examiner has set forth new arguments which were not necessitated by an Amendment by the Appellant, Appellant respectfully submits that the status of finality is improper and thereby requests that the Pre-Appeal Brief Review board recommend a withdrawal of finality. The Examiner also alleges that "the applicant also admits in the remarks section that Chen does teach the claimed invention (see last three lines of page 8)".⁹ This statement is simply not true since the section referred to by the Examiner reads "[t]he Applicant acknowledges that Chen teaches transmitting an encoded signal including a

² See page 2 of the Office Action mailed on June 6, 2005.

³ Column 1, lines 34-38 of the Chen Patent.

⁴ See the arguments made on pages 8 and 9 of the Request for Reconsideration filed on February 10, 2005.

⁵ See page 3 of the Office Action mailed on June 6, 2005.

⁶ See the arguments made on page 9 of the Request for Reconsideration filed on February 10, 2005.

⁷ See page 2 of the Office Action mailed on June 6, 2005.

⁸ See pages 11-13 of the Office Action mailed on June 6, 2005.

⁹ See page 12 of the Office Action mailed on June 6, 2005.

watermark to a receiver and decoding the signal” and this acknowledgment of Chen’s teachings does not address, for example, the above-described deficiency of Chen.¹⁰

Further, the Examiner refers the Appellant to operations of the information extractor 202 as being read upon by the claimed invention.¹¹ For reasons discussed in detail below and not previously presented (due to their introduction only in the previous Office Action), Appellant respectfully disagrees.

Chen discusses the functionality of the information extractor 202 substantially within Column 33, lines 16-42 of the Chen patent with respect to Figure 9.¹² As a review of this section will reveal, the information extractor 202 is well named because it simply extracts information.¹³ The information extractor 202 is responsible for extracting or decoding information present in a watermark signal, not performing a transmission operation in response to said decoded information.¹⁴ The Examiner appears to indicate the synchronization of the composite signal is performed in response to the decoded/extracted information from the watermark.¹⁵ However, the synchronization of portions of the composite signal is performed in order to correctly extract/reconstruct the watermark, and as such is performed before the watermark signal is decoded/extracted.¹⁶ Appellant again cannot understand how Chen can disclose operations performed in response to a decoding operation if the alleged operations occur before the decoding.

In view of the above remarks, Appellant respectfully requests that the Pre-Appeal Brief Review Board find in favor of the Appellant with regard to the withdrawal of the improper 35 U.S.C. § 103(a) reference of Chen in view of Moskowitz as well as with regard to the improper finality of the June 6, 2005 Office Action.

Reconsideration and allowance of all pending claims is respectfully requested.

¹⁰ See the arguments made on Page 8 of the Request for Reconsideration filed on February 10, 2005.

¹¹ See page 12 of the Office Action mailed on June 6, 2005.

¹² See column 33, lines 16-42 and Figure 9 of the Chen patent.

¹³ *Id.*

¹⁴ *Id.*

¹⁵ See page 12 of the Office Action mailed on June 6, 2005.

¹⁶ See column 33, lines 16-42 and Figure 9 of the Chen patent.

CONCLUSION

Accordingly, in view of the remarks, reconsideration of the objections and rejections and allowance of each of claims 1-26 in connection with the present application is earnestly solicited.

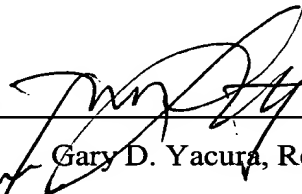
Should there be any outstanding matters that need to be resolved in the present application, the Pre-Appeal Brief Review Board is respectfully requested to contact the undersigned at the telephone number.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Very truly yours,

HARNESS, DICKY & PIERCE, PLC

By

 45,274

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